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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/348,469      | 07/07/1999  | AUSTIN GERARD SMITH  | 06999.0001-0        | 5288             |

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EXAMINER

PARAS JR, PETER

ART UNIT

PAPER NUMBER

1632

18

DATE MAILED: 07/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/348,469

Applicant(s)

SMITH ET AL.

Examiner

Peter Paras, Jr.

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☒ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 22-24,26-29,32-34,41 and 42.

Claim(s) withdrawn from consideration: 30 and 31.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE: The proposed amendments to claims 22-24, 26-29, 32-34 and 41-42 raise new issues that require further consideration and search. For example, the newly proposed claim limitations in which X and Y are DNA sequences homologous with a host gene sequence would require a new search. Further, the newly proposed claim limitations appear to necessitate new grounds of rejection-double patenting. Newly proposed claims 47-60 raise issues of new matter as the specification does not appear to support the DNA construct A-P-B-Q-C as embraced by the claims. Finally newly proposed claims 47-60 were added but none of the previously pending finally rejected claims were cancelled.

Continuation of 3. Applicant's reply has overcome the following rejection(s): With respect to proposed claims 22-24, 26-29, 32-34 and 41-42 all of the previous rejections would be withdrawn. Also, proposed claims 22-24, 26-29, 32-34 and 41-42 would be entitled to a priority claim to parent application 08/537,765.

Continuation of 5. does NOT place the application in condition for allowance because: The proposed amendments to claims 22-24, 26-29, 32-34, and 41-42 while overcoming the previous rejections of record have also necessitated new grounds of rejection under double patenting. New proposed claims 47-60 would be rejected under 35 U.S.C. 112, 1st paragraph and 35 U.S.C. 102. However, since the proposed amendment will not be entered all the previous rejections are maintained for the reasons of record.

Continuation of 10. Other: The IDS submitted on 7/9/03 has not been considered as the submission has not complied with the requirement for filing an IDS after final rejection. See MPEP 609.

**PETER PARAS**  
**PATENT EXAMINER**

